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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,574	11/28/2003	Karl-Heinz Wendt	1085-029	8642
47888	7590	09/13/2005	EXAMINER	
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			CAMERON, ERMA C	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,574

Applicant(s)

WENDT, KARL-HEINZ

Examiner

Erma Cameron

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 6-16 have been amended to recite a method and all article claims are therefore withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 25, 2005.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-17 and 19-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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a) page 6 - “residual deposits on the glass are removed...” It is not clear what these deposits are, where they come from, or at what time they are removed. Are these deposits from the acrylate lacquer?

b) page 6 - “...removed from the coating again without a race.” The meaning of this is not clear.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-17 and 19-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 1, last line: there is no antecedent basis for “the coating”.

b) Claim 2: it is not clear how these steps fit in it with the steps of claim 1, and therefore these steps are vague. Moreover, steps 2 and 3 necessarily go together, as removing masking film would not make sense unless it had first been applied.

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c) Claim 2: it is not clear what the residual coatings are, or where they come from. Are these residual coatings from the polyacrylate lacquer?

d) Claim 2: there is no antecedent basis for "the partially or completely cured coating".

There is no suggestion in claim 1 that the coating may be only partially cured.

e) Claim 2: there is no antecedent basis for "the pointed edges". It is not clear what the pointed edges are or what material they are.

f) Claim 4: it is not clear what the residual coatings are, or what material they are. Does this refer to the polyacrylate lacquer?

g) Claims 2, 4, 5, 10 and 25: the phrases "in particular" and "preferably" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

h) Claim 11: it is not clear what is meant by acrylic glass. Glass is typically silicon dioxide.

i) Claim 13: it is not clear if the lacquer is actually obtained or not, or if it is merely "obtainable".

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- j) Claim 13: it is not clear what is modified by “optionally protected”, and what the nature of the protection is.
- k) Claim 15 and 26: it is not clear if both hydrocarbons and esters must be present, or if these are a Markush group. In addition, because ester and alkoxy ester overlap, this claim is vague.
- l) Claim 15: what does 4 to 12 modify?
- m) Claim 17: there is no antecedent basis for “all residue”, and it is not clear what this residue is, or at what point in time it is removed.
- n) Claim 20: there is no antecedent basis for “said alcohol solvent”.
- o) Claims 20 and 21: it is not clear what is meant by “independently of”. What is independent of what?
- p) Claim 24: should be put into proper Markush terminology – selected from the group consisting of. In addition, it is not clear if the composite glass needs to have both the glasses present, or if the composite glass is selected from these two glasses.
- q) Claim 26: it is not clear what “with 6 to 10 carbon atoms” modifies.

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r) Claim 14: there is no antecedent basis for "the solvent".

Claim Objections

6. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 6 does not further limit independent claim 1.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 5-16 and 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bock et al (6020419).

'419 teaches applying (by spraying) a two-component composition of a binder of an acrylate and diisocyanate curing agent, plus particles such as silica and titanium dioxide (a

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coloring agent), in solvents such as hydrocarbons, alcohols such as ethanol, and esters, and optionally silanes, to glass and other materials (3:17-7:26). The composition may be water-free (4:19-26). After application the composition is cured (see Examples). The film thickness is 30-50 microns (see Table 3; the examiner assumes that m is micron, it would not make sense to have a 30 meter film thickness).

'419 does not teach cleaning or priming the glass first, but it is conventional to at least clean a surface before applying another layer. It is also conventional to mask an area to be coated.

The particles are below 200 nm (3:40-45), which is lower than applicant's claimed range, but it would have been obvious to one of ordinary skill in the art to have optimized the particle size through no more than routine experimentation.

'419 teaches to apply the composition to glass in general, which would be inclusive of fire-resistant, composite or safety glass.

The surface tension would be inherent to the coating used.

9. Claims 1-3, 5-7, 10-16, 19, 22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 665252.

'252 teaches a 2-pack coating composition for glass that comprises an acrylic polymer and a polyisocyanate with at least two isocyanate groups (2:21-54). Solvents such as alcohols such as isopropanol or ester solvents may be present (9:31-47) at up to 40 wt%. There is present coloring or metallic pigments (10:1-5). The composition is applied by spraying and other means,

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and the film thickness is 1-1000 microns, which overlaps with applicant's claimed thickness (10:6-10). After application to glass, the composition is cured (12:49-58).

'252 does not teach cleaning or priming the glass first, but it is conventional to at least clean a surface before applying another layer. It is also conventional to mask an area to be coated.

The particle size of the pigments is not stated, but it would have been obvious to one of ordinary skill in the art to have optimized the particle size through no more than routine experimentation.

'252 teaches to apply the composition to glass in general, which would be inclusive of fire-resistant, composite or safety glass.

The surface tension would be inherent to the coating used.

10. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over bock et al (6020419) taken in view of DE 10017363.

'419 is applied here for the reasons given above.

'419 does not teach that the coating on glass is removable.

'363 teaches that an acrylate coating on glass is a protective varnish that can be removed without damaging the glass.

It would have been obvious to one of ordinary skill in the art to have used the '363 removable process on the '419 coating if removable was desired because of the teaching of '363 that an acrylate coating may be removed from glass without damaging the glass.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ERMA CAMERON
PRIMARY EXAMINER

Erma Cameron
Primary Examiner
Art Unit 1762

September 11, 2005